

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONRAD V. ANDERSON,
JOHN R. DAVID, and RONALD STEELMAN

Appeal No. 2005-1222
Application No. 09/759,993

ON BRIEF

MAILED
SEP 30 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before KRATZ, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand this application to the examiner for further consideration and action not inconsistent with our opinion below. See 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

Appellants' invention relates to a method and apparatus for removing adhesive film from a substrate.

Claims 1, 4, 8-13, 17, 21, 22 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by French Patent Publication 2 643 487 (Apollonio et al); claims 1, 5, 8-10, 12, 18, 21, 22 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kuroda (U.S. Patent No. 5,891,298); claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Apollonio et al.¹

While the examiner mentions the claim numbers of the claims that are subject to each of the anticipation rejections, the analysis of each of the claims so rejected and how each of the applied references meets each of those claims essentially ends there, except for the rejection of claim 13 over Apollonio.

Rather than focusing on the specific claim language of each of the rejected claims and explaining how each of the limitations of each of the rejected claims is described in the anticipation rejections, the examiner explains how several of the drawing

¹ The examiner also indicates that Stadtmueller (presumably another prior art reference) should be seen, as set forth in the body of the § 103(a) rejection but does not otherwise explain why that reference is relevant or include that reference in the list of prior art relied upon and the statement of the rejection.

figures of each of the separately applied references allegedly correspond with Figure 4 of appellants' drawings.²

Manifestly, such an approach by the examiner without also furnishing a claim by claim analysis as to how the prior art is being applied does not serve to explain how each of the applied references are being employed to meet all of the limitations of each claim rejected as being anticipated. Indeed, in taking this approach the examiner has incorrectly found that appellants have furnished reasons why all of the grouped claims set forth by appellants in their brief do not stand or fall together, whereas appellants clearly state the opposite at page 6 of the brief.³

We decline to review the merits of the anticipation rejections, on this record. Moreover, as alluded to in footnote 1 of this remand, we are unable to determine from the examiner's obviousness rejection in this case exactly which reference or

² In making this comparison, the examiner appears to have referred incorrectly to several features of the applied patents. For example, the roll (18) of Kuroda is described in the patent as a peeling tape supply roller and roll (8) of the same patent is described as a peeling tape applying roller whereas the examiner refers to these items as a take up roll and compressive roller, respectively at page 4 of the answer.

³ Of course, if the examiner had appropriately presented a full analysis as to how the prior art was being applied to all of the appealed claims in the final rejection, as is appropriate, appellants may have chosen to argue some of the claims in a separate way in the brief or, if convinced by the examiner's analysis, perhaps decided not to appeal at all.

references are even relied upon as evidence of obviousness. Of course, any reference actually being relied upon by the examiner in rejecting the claims should be listed in the statement of rejection and the section of the answer directed to furnishing a list of all references relied upon in all of the rejections.

As an additional point, appellants filed a reply brief on November 26, 2003. Discussed therein are several of appellants' arguments with respect to the several rejections maintained by the examiner in the answer mailed September 30, 2003. The examiner noted the Reply Brief had been entered and forwarded the application to the Board as was an appropriate option under patent regulations as they pertain to examining procedures following the submission of a reply brief at that time.

Our review of appellants' brief and reply brief reveals that the arguments furnished in the reply brief with regard to appellants' view as to whether the examiner has established a prima facie case of anticipation and/or obviousness of the claimed subject matter in any or all of the stated rejections are significantly augmented and differ somewhat from the arguments furnished in the brief seemingly at least in part due the evolving approach taken by the examiner in discussing the applied

references as a comparison of the final rejection and answer reveals.

Prior to rendering a decision in this appeal, it is appropriate that we be apprised of the examiner's analysis and viewpoint concerning all of appellants arguments as presented in the brief and the additional substantive arguments furnished in the reply brief. Consequently, we remand this application to the examiner to take further action not inconsistent with the above.

Accordingly, we remand this application to the jurisdiction of the examiner for a thorough and careful consideration of the matters discussed above by either reopening prosecution; or, in a Supplemental Examiner's Answer that addresses each of the rejected claims, if the latter option is deemed appropriate by the examiner under regulations and examining practice that are currently in effect.

Pursuant to the provisions of 37 CFR § 41.50(a)(2) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), appellants are required to timely respond to any supplemental examiner's answer that the examiner may decide to issue in response to this remand as set forth in the above-noted regulation.

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01 (D) (8th ed., Rev. 2, May 2004, p. 700-126). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this application.

REMANDED

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